

**REMARKS**

The Office Action rejected claims 1-21 and objected to claims 22 and 23. Applicants amended claim 23 and added new claims 32-42. Claims 1-42 remain. Applicants respectfully request that the Examiner reconsider and withdraw the objections and rejections.

**Information Disclosure Statement**

Applicants submitted an Information Disclosure Statement (IDS) with the Request for Continued Examination filed on 22 December 2003. However, the Office Action did not include the completed Form PTO-1449 indicating that the Examiner considered the IDS. Applicants request that the Examiner provide a completed Form 1449 in the next correspondence with Applicants.

Applicants also submitted another IDS on 13 April 2004, after the date of this Office Action. Applicants request that the Examiner consider the references cited thereon, and provide a copy of the completed Form PTO-1449

**Claim Rejections - 35 USC § 102**

The Office Action rejected claims 1-4 and 7-21 as being anticipated by United States Patent Number 6,536,773 to Datta ("Datta"). As stated previously, the rejection was improper and must be withdrawn.

Independent claims 1 and 12 use the partially closed language "comprises essentially of" (claim 1) and "essentially just" (claim 12). Such partially closed language "limits the scope of a

claim to the specified elements 'and those that do not materially affect the basic and novel characteristic(s)' of the claimed invention." M.P.E.P. § 2111.03 (citing *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original). The Examiner believes that the presence of the rails does not materially affect the basic and novel characteristics of the claimed invention. Applicants disagree.

Paragraph 8 of the specification states one object of the present invention - to provide a brush seal "made from fewer components." Once the plates and bristle assemblies are stacked, as described in paragraph 73 of the specification, the components are preferably fusion welded together. At that point, the side plate and back plate provide structural support to the bristles. The inclusion of "supports" such as the rings of Datta would be unnecessary for the present invention. Recall, as stated in paragraph 67 of the specification, the purpose of the joint is to allow the operator to manipulate the bristle assembly before assembly of the brush seal. The purpose of the rings in Datta is structural support. (*see, e.g.* Figure 4). Therefore, considering the inclusion of rings as not affecting the basic and novel characteristics of the claimed invention, was improper. Applicants request that the Examiner reconsider and withdraw the rejection.

The Office Action rejected claims 1-10, 12-20 and 24-31 as being anticipated by United States Patent Number 5,106,104 to Atkinson et al. ("Atkinson"). As stated previously, the rejection was improper and must be withdrawn.

Independent claims 1 and 12 recite that the claimed bristle arrangement is "for subsequent use in a brush seal." The Examiner believes such phrase is a statement of intended

use. Regardless, however, the Examiner must still evaluate such language "to determine whether the recited purpose or intended use results in a structural difference ... between the claimed invention and the prior art." M.P.E.P. § 2111.02.

In performing this evaluation, Applicants believe that the Examiner overlooked the term "subsequent" in the phrase. The term "subsequent" define when, in the build-up, the bristle arrangement includes those features. Specifically, the bristle arrangement includes those features before assembly of the brush seal. Atkinson does not show all of the recited features before build-up of the brush seal. Accordingly, such phrase results in a structural difference between the claimed invention and the prior art. Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection.

#### **Allowable Subject Matter**

Claims 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. As discussed above, independent claim 12 defines an invention that is patentable over the cited references. Accordingly, the objection was improper and should be withdrawn.

#### **Newly Added Claims**

Applicants added new claims 32-42. The newly added claims follow claims 1-11, except that independent claim 32 uses the closed ended language "consists of." The newly added claims define inventions that are patentable over the cited references.

### Other Amendments

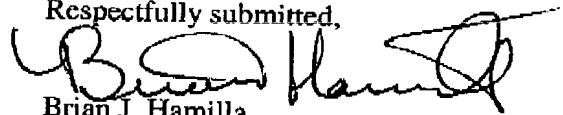
Applicants modified claim 23 so as not to depend from itself. Claim 23 now depends from claim 22.

### Conclusion

In light of the foregoing, Applicants submit that the claims are now in condition for allowance. Applicants request that the Examiner reconsider and withdraw the restriction requirement and rejection. Applicants solicit the allowance of Claims 1-42 at an early date.

Applicants authorize the Commissioner to charge the \$284 fee ( $11 \times \$18 = \$198$ , and  $1 \times \$86$ ) due under 37 CFR 1.16(c) for the presentation of eleven (11) claims in excess of twenty (20) and one (1) independent claim in excess of three (3), and any fee due under 37 CFR 1.16 or 17, or to credit any overpayments, during prosecution of this Application, to Deposit Account Number 21-0279.

Respectfully submitted,

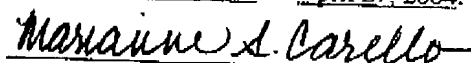


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